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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MCCLAIN, GERALD

ART UNIT

PAPER NUMBER

3653

MAIL DATE

DELIVERY MODE

02/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/522,855	Applicant(s) YAMAMOTO ET AL.	
	Examiner GERALD W. MCCLAIN	Art Unit 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2 January 2008 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In Claim 19, last line, the term "only" excludes other structures, wherein the specification clearly indicates that other structures are present at the cut in multiple locations.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 19, last line, it is unclear what structure in what location(s) is excluded by the term "only" since there is material connected to the cut portion.

Claim Rejections - 35 USC § 102

Claims 1, 16, and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujiwara (US 2003/0164317 A1).

Claims 1 and 16: package member (1); sheet package (1); printer (30); side part (paragraph [0012]); portion (see Fig. 1-4); front edge (around 13); rear edge (around 3); projecting part (34 and 36); sheet storage unit (37); (Note: the projecting part is not claimed to move.)

Claim 18: first part and second part (see Fig. 3 below);

Claim 19: perforated portion and cut portion (paragraph [0012]).

Claims 1-5, 9, 15-16, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moser (US 4,494,746) in view of Fujiwara. Moser discloses:

Claims 2 and 3: package member (1); perforated line (See Fig. 5 below, line A); side part into two parts (8 and 10 sections);

Claim 5: pressing member (3); concave part (17 and 18; Note: the part detail is not shown. However, any cut is *inherently* concave at some point on its profile.); side wall of the sheet storage unit (7); side part (8 and 10); pushing member (4 and 11);

Claim 9: projecting part (3); level difference (See Fig. 1 below, B level; Note: B is “formed in” 7 since B passes through 7.); side wall of the sheet storage unit (7); side part (1 along which 6 is part);

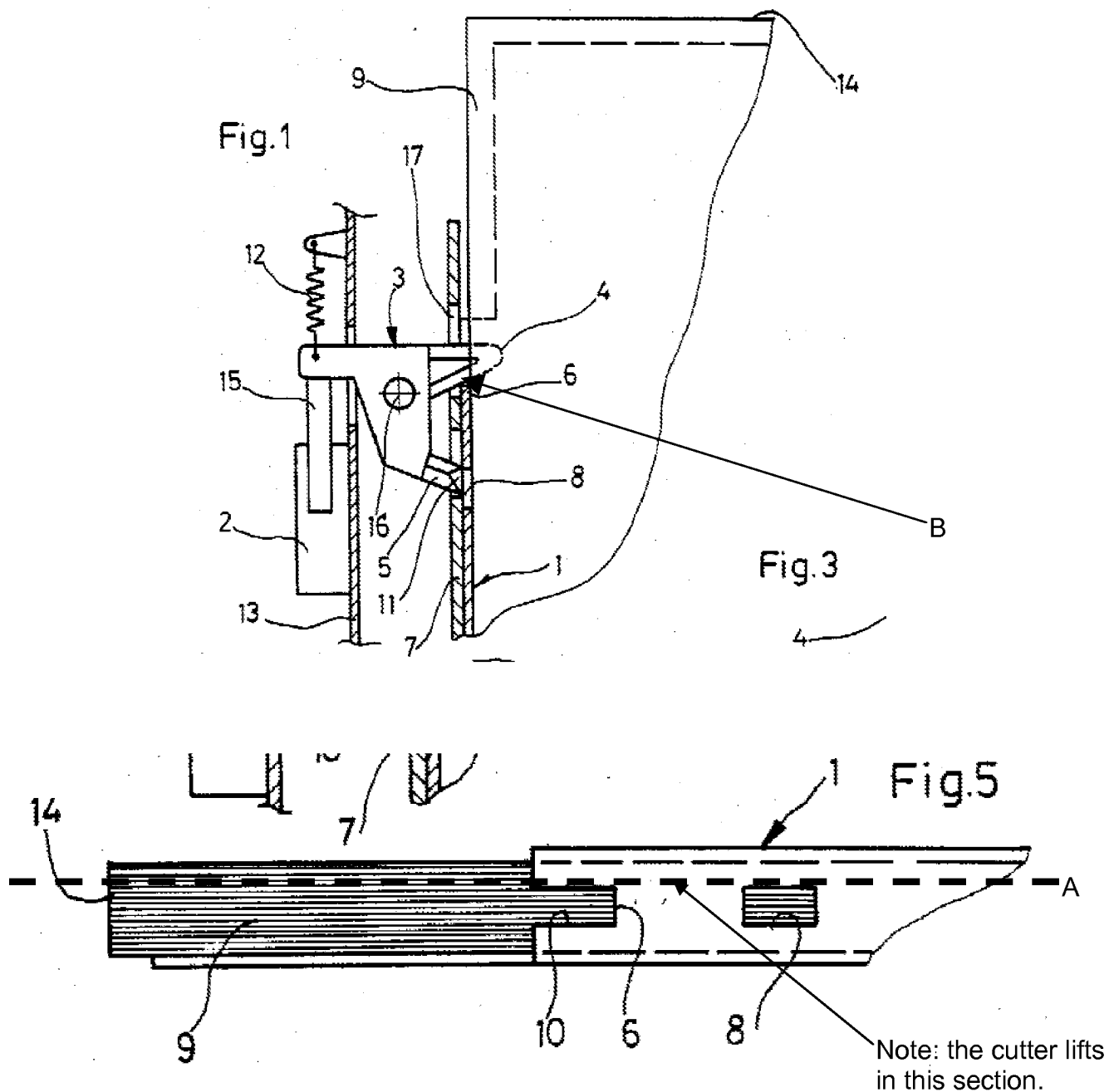
Claim 15: sheet package (1); paper (column 3, lines 5-6; Note: cardboard contains paper);

Claim 18: first part and second part (8 or 10/6 on opposite sides of 1);

Claim 19: perforated portion and cut portion (6/8/10).

Moser does *not directly* show the side part at a first and second position.

Fujiwara shows a similar device having the side part at a first and second position (2) for the purpose of reliably picking up sheets one at a time right up to the final sheet (paragraph [0007]). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention to modify Moser as taught by Fujiwara and include Fujiwara’s similar device having the side part at a first and second position for the purpose of reliably picking up sheets one at a time right up to the final sheet.



Claims 1-4, 9, and 13-19, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki, et al. (US 2002/0056961 A1) ("Sasaki") in view of Fujiwara. Sasaki discloses:

Claims 1 and 16-17: package member (10); sheet package (10); printer (abstract); side part (23 and 25); edge (23 and 25; See FIG. 6 below, note that the front sections are identified in regions.); sheet storage unit (40); projecting part (55); (Note: at *least one of the sides* of the sheets is capable of being in flush contact with the projecting member, especially as the user places the package into the storage unit.)

Claims 2 and 3: package member (10); perforated line (23 and 25, Note: 23 and 25 were are *capable of* being provided with perforated lines to cut them); side part into two parts (23 and 25);

Claim 4: projecting part (55); sheet storage unit (40); pressing member (55; Note: every action has an equal and opposite reaction. Therefore, 55 presses the stack of sheets when they press 55.);

Claim 9: projecting part (55); level difference (See FIG. 6, 50 and 52); side wall of the sheet storage unit (55 at 40); side part (23 and 25);

Claim 13: sheet package (10); single sheet-like member (paragraph [0069]);

Claim 14: sheet package (10); fold-back part (11h);

Claim 15: sheet package (10); paper (paragraph [0069])

Claim 18: first part and second part (23/25);

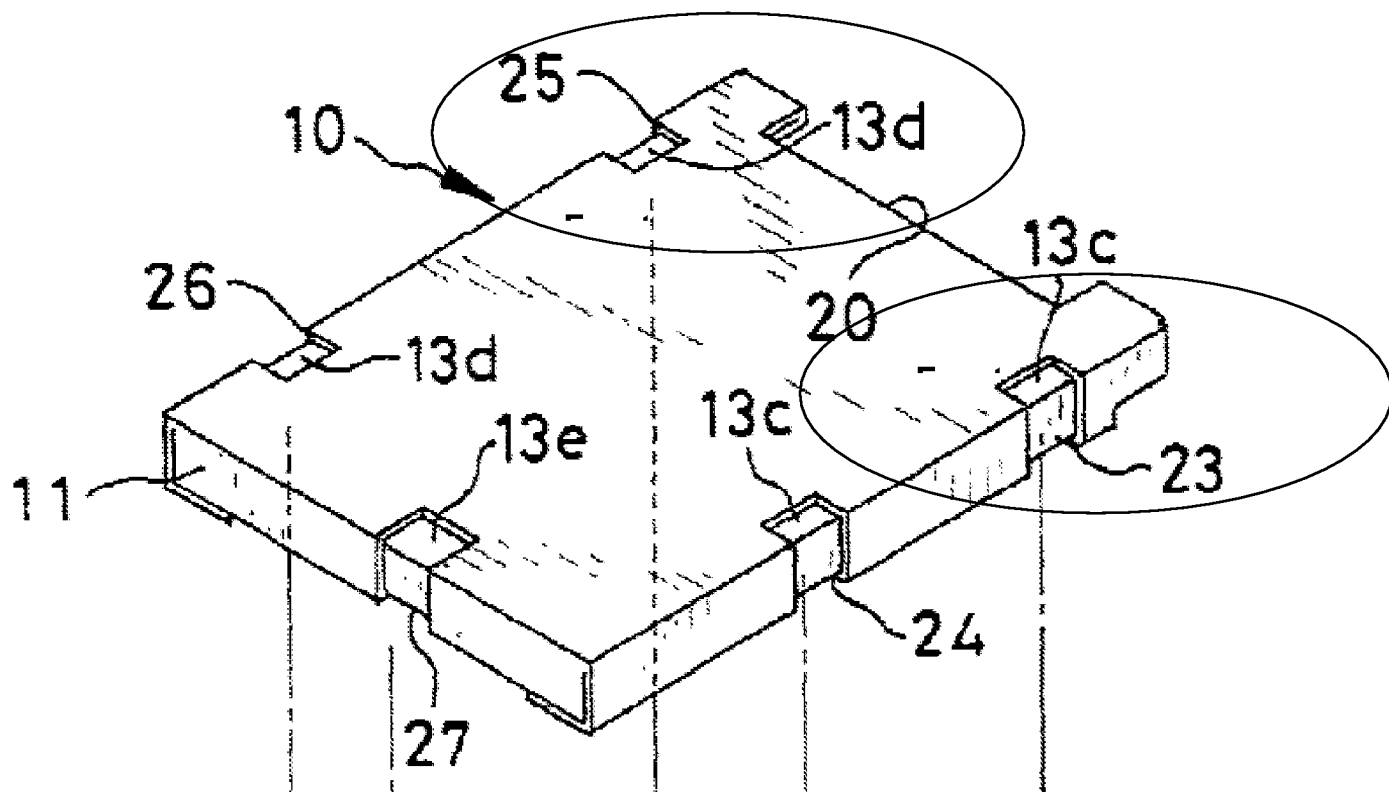
Claim 19: perforated portion and cut portion (23/25).

Sasaki does *not directly* show the side part at a first and second position.

Fujiwara shows a similar device having the side part at a first and second position (2) for the purpose of reliably picking up sheets one at a time right up to the final sheet (paragraph [0007]). Therefore, it would have been obvious to a person

Art Unit: 3653

having ordinary skill in the art at the time the invention to modify Sasaki as taught by Fujiwara and include Fujiwara's similar device having the side part at a first and second position for the purpose of reliably picking up sheets one at a time right up to the final sheet.

FIG. 6

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moser in view of Fujiwara and further in view of Ishiduka, et al. (US 6,217,019) ("Ishiduka"). Moser discloses all the limitations of the claims as discussed above. Moser

Art Unit: 3653

does not directly show a sensor provided to the sheet storage unit, or a difference between a length of the side part in the sheet feed direction after the removal of the one of the two parts at the perforated line and a distance from the pressing member to a rear wall of the sheet storage unit in the sheet feed direction is smaller than a maximum permissible displacement of the mark for the sensor wherein the mark indicates the type of the stack of sheets.

Ishiduka shows a similar device having a sensor provided to the sheet storage unit, or a difference between a length of the side part in the sheet feed direction after the removal of the one of the two parts at the perforated line and a distance from the pressing member to a rear wall of the sheet storage unit in the sheet feed direction is smaller than a maximum permissible displacement of the mark for the sensor wherein the mark indicates the type of the stack of sheets (column 6, lines 17-32; FIG. 1 and 3A) for the purpose of allowing the printer to read the paper information from the mark (column 6, lines 22-23). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention to modify Moser as taught by Ishiduka and include Ishiduka's similar device having a sensor provided to the sheet storage unit, or a difference between a length of the side part in the sheet feed direction after the removal of the one of the two parts at the perforated line and a distance from the pressing member to a rear wall of the sheet storage unit in the sheet feed direction is smaller than a maximum permissible displacement of the mark for the sensor wherein the mark indicates the type of the stack of sheets for the purpose of allowing the printer to read the paper information from the mark.

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki in view of Fujiwara and further in view of Ishiduka. Sasaki discloses all the limitations of the claims as discussed above. Sasaki does not directly show a sensor provided to the sheet storage unit, or a difference between a length of the side part in the sheet feed direction after the removal of the one of the two parts at the perforated line and a distance from the pressing member to a rear wall of the sheet storage unit in the sheet feed direction is smaller than a maximum permissible displacement of the mark for the sensor wherein the mark indicates the type of the stack of sheets.

Ishiduka shows a similar device having a sensor provided to the sheet storage unit, or a difference between a length of the side part in the sheet feed direction after the removal of the one of the two parts at the perforated line and a distance from the pressing member to a rear wall of the sheet storage unit in the sheet feed direction is smaller than a maximum permissible displacement of the mark for the sensor wherein the mark indicates the type of the stack of sheets (column 6, lines 17-32; FIG. 1 and 3A) for the purpose of allowing the printer to read the paper information from the mark (column 6, lines 22-23). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention to modify Sasaki as taught by Ishiduka and include Ishiduka's similar device having a sensor provided to the sheet storage unit, or a difference between a length of the side part in the sheet feed direction after the removal of the one of the two parts at the perforated line and a distance from the pressing member to a rear wall of the sheet storage unit in the sheet feed direction is

smaller than a maximum permissible displacement of the mark for the sensor wherein the mark indicates the type of the stack of sheets for the purpose of allowing the printer to read the paper information from the mark.

Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moser in view of Fujiwara and further in view of Ishiduka. Moser discloses all the limitations of the claims as discussed above. Moser does not directly show a package member provided with a mark which can be read by a sensor provided to the sheet storage unit, or a length of the side part in the sheet feed direction after the removal of the one of the two parts at the perforated line that is substantially equal to a distance from the level difference to a rear wall of the sheet storage unit in the sheet feed direction.

Ishiduka shows a similar device having a package member provided with a mark which can be read by a sensor provided to the sheet storage unit, and a length of the side part in the sheet feed direction after the removal of the one of the two parts at the perforated line that is substantially equal to a distance from the level difference to a rear wall of the sheet storage unit in the sheet feed direction (column 6, lines 17-32; FIG. 1 and 3A) for the purpose of allowing the printer to read the paper information from the mark (column 6, lines 22-23). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention to modify Moser as taught by Ishiduka and include Ishiduka's similar device having a package member provided with a mark which can be read by a sensor provided to the sheet storage unit, and a length of the

side part in the sheet feed direction after the removal of the one of the two parts at the perforated line that is substantially equal to a distance from the level difference to a rear wall of the sheet storage unit in the sheet feed direction for the purpose of allowing the printer to read the paper information from the mark.

Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki in view of Fujiwara and further in view of Ishiduka. Sasaki discloses all the limitations of the claims as discussed above. Sasaki does not directly show a package member provided with a mark which can be read by a sensor provided to the sheet storage unit, or a length of the side part in the sheet feed direction after the removal of the one of the two parts at the perforated line that is substantially equal to a distance from the level difference to a rear wall of the sheet storage unit in the sheet feed direction.

Ishiduka shows a similar device having a package member provided with a mark which can be read by a sensor provided to the sheet storage unit, and a length of the side part in the sheet feed direction after the removal of the one of the two parts at the perforated line that is substantially equal to a distance from the level difference to a rear wall of the sheet storage unit in the sheet feed direction (column 6, lines 17-32; FIG. 1 and 3A) for the purpose of allowing the printer to read the paper information from the mark (column 6, lines 22-23). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention to modify Sasaki as taught by Ishiduka

and include Ishiduka's similar device having a package member provided with a mark which can be read by a sensor provided to the sheet storage unit, and a length of the side part in the sheet feed direction after the removal of the one of the two parts at the perforated line that is substantially equal to a distance from the level difference to a rear wall of the sheet storage unit in the sheet feed direction for the purpose of allowing the printer to read the paper information from the mark.

Response to Arguments

Applicant's arguments filed 2 January 2008 have been fully considered but they are not persuasive.

Regarding the diagonal “side part”, since the diagonal profile has a profile component in the “feed sheet direction”, it anticipates the claims.

Regarding a front edge contacting a projecting part, see paragraph [0042] and Fig. 4 and 7 below. Front edge 4, which includes the front edge of the diagonal section, contacts the projecting part 36.

Fig. 4

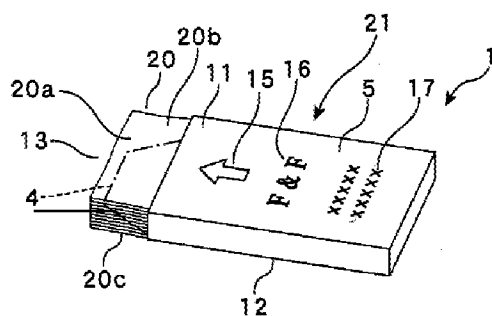
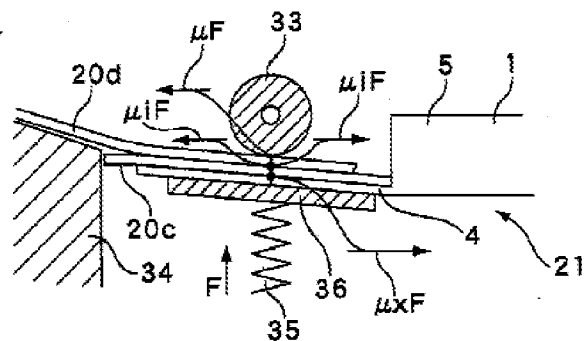


Fig. 7



Applicant states the following.

Art Unit: 3653

Thus, Moser does not teach or suggest (1) "the side part being in parallel with the sheet feed direction;" or (2) "the side part is structured such that the front edge contacts with a projecting part formed in the sheet storage unit;" as recited in independent claim 1 and as similarly recited in independent claim 16.

Regarding (1), a direction vector is a line and a side is a plane. Therefore, there are possible parallel planes that rotate around the direction vector and that may be offset from said vector while still being parallel. Since side part 1/6 (plane) of Moser is parallel with the sheet feeding direction (line).

Regarding (2), the side part front edge 1/6 does contact a projecting part 3.

The same reasoning is purported to the "alleged combination of Sasaki and Fujiwara". The same reasoning is applied such that the side parts are 23/25 and the projecting parts are 50/55.

In response to applicant's argument that "Ishiduka does not teach or suggest (1) ... or (2) ...", the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Regarding Claim 18, the fact that "the belt-like member that is the boundary between these parts ..." is irrelevant in that there still exists first and second parts that are detachable on opposing sides of the package member as shown in the rejections above.

Regarding Claim 19, nowhere in the Fujiwara ('317) reference (including paragraph [0012]) are there disclosed "burrs". Further, Applicant states that there are "perforations" of cut and uncut parts. In these "perforations", a "cut portion" is present. Therefore, "the front edge of the side part contains a perforated portion and a cut portion."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERALD W. MCCLAIN whose telephone number is (571)272-7803. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

Art Unit: 3653

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gerald W. McClain
Examiner
Art Unit 3653

/Patrick H. Mackey/
Supervisory Patent Examiner, Art
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